



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

M

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,891	08/07/2001	Vincent Bryan	46739/262602	3548

27683 7590 08/13/2003  
HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 08/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

# Office Action Summary

Applicati n No.

09/923,891

Applicant(s)

BRYAN ET AL.

Examiner

Pedro Philogene

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-338 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-338 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 27-33, drawn to an apparatus for positioning a subject, classified in class 606, subclass 130.
- II. Claims 1-10, 311, drawn to a method for determining the size of a prosthesis, classified in class 623, subclass 17.16.
- III. Claims 11-26, 199-201, drawn to a method of preparing an intervertebral disc space, classified in class 606, subclass 60.
- IV. Claims 34-94, 248, 309-315, drawn to a method of implanting an intervertebral disc, classified in class 623, subclass 17.11.
- V. Claims 95-106, drawn to a system for positioning and stabilizing surgical instruments, classified in class 606, subclass 104.
- VI. Claims 115-127, drawn to a method for positioning surgical instruments, classified in class 606, subclass 1.
- VII. Claims 128-138, 202-205, drawn to a method for locating a preferred positioning for a prosthesis, classified in class 128, subclass 898.
- VIII. Claim 154, drawn to a system for guiding site preparation instruments, classified in class 606, subclass 96.
- IX. Claims 194-198, drawn to a method of adjusting the position machining fixture, classified in class 606, subclass 102.

- X. Claims 213-214, drawn to a method for confirming a correct position of a machining fixture, classified in class 606, subclass 87.
- XI. Claims 217-235, drawn to a system for machining the space, classified in class 606, subclass 79.
- XII. Claims 245-247, 249, 250-253 306, drawn to a system for separating and maintaining separation of the bones, classified in class 606, subclass 90.
- XIII. Claims 258, 259, 260-305, 307, 308, 316-338, drawn to a method of implanting an intervertebral disc prosthesis, classified in class 606, subclass 61.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II -XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method as claimed could be performed by a materially different product that set forth in claims 27-33.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 3732

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-XIII, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: FIGS 1-4, relating to claims 27-33.

FIGS 5-10 relating to claims 107-111.

FIGS 15-17 relating to claims 112-114.

FIGS 11,12 relating to claim 153.

FIGS 31-38 relating to claims 156-176, 181-186,189-193, 206-212.

FIGS 39 A-C relating to claims 177-180,187,188.

FIG 49 relating to claims 215,216.

FIGS 55-58, 69-71 relating to claims 236-237.

FIG 60 relating to claims 238,239.

FIG 61 relating to clais 240-242.

FIGS 62-65 relating to claims 243-244.

FIG 72 relating to claims 254-256.

FIG 74 relating to claim 257.

FIGS 21-32 relating to claims 139-152

Art Unit: 3732

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

No telephone call was made to request an election to the above restriction requirement.

Art Unit: 3732


A shortened statutory period for response to this restriction requirement is set to expire one (1) month from the date of this action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 305-3591 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
PEDRO PHILOGENE  
PRIMARY EXAMINER

Pedro Philogene  
August 11, 2003